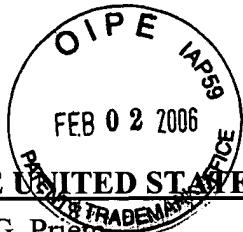


S/N 10/657,758



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Dan G. Priem

Examiner: Julio Gonzalez

Serial No.: 10/657,758

Group Art Unit: 2834

Filed: September 8, 2003

Docket: 1094.204US1

Title: AUTOMATIC GENERATOR STARTING PROTECTION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in this application. No amendments are being filed herewith, however, amendments to dependent claims 7-15, 21, 23-24, 26-28, and 32 were submitted in response to the final rejection, but were NOT been entered. This request is being filed with a Notice of Appeal. Review is requested for the reason(s) stated below.

1. The § 103 Rejection of claims 1, 5, 7, 20 and 21 using Reuyl in view of James

No *prima facie* case of obviousness exists for these claims because these references do not suggest being combined in the manner of the Office Action. The Office Action asserts:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design a system as disclosed by Reuyl and to use the teachings of James et al. for the purpose of monitoring efficiently carbon monoxide levels to disable a device if there is a risk of exhaust hazard.

(Office Action ¶ 2.) Although James recognizes the CO hazard of an already-running engine, it fails to recognize a potential hidden CO hazard of an engine that is not yet running, but which has auto-starting capability. While Reuyl relates to automatically starting an auto engine, it relies on a completely different approach to dealing with the resulting exhaust—it expressly teaches venting exhaust outside the residence. (*See* Reuyl at column 7, lines 49-50.) Therefore, Reuyl fails to suggest any need for the James device, but instead handles exhaust in a completely different way—by venting away the gases. Thus, Reuyl completely ignores any risk of exhaust hazard. James only recognizes the CO hazard of an already-running auto—nothing in James suggests automatic engine starting, or any resulting latent CO hazard.

In sum, James deals with the problem of a CO hazard of an already-running motor vehicle. Reuyl deals with the problem of automatic starting an already-vented engine. Thus,

Reuyl and James solve different problems—from each other and from the present patent application. Nothing in Reuyl and James recognizes the problem of a hidden CO hazard of a generator with automatic starting capability. Nothing in Reuyl and James teaches the legally required desirability of their combination. *See In re Sang Su Lee*, 277 F.3d 1338; 61 U.S.P.Q.2D 1430 (Fed. Cir. 2002) (motivation to combine references must be supported by evidence in the record); *See also n re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

The combination of James and Reuyl impermissibly relies on the hindsight of the Appellant's own disclosure, instead of on any suggestion in James and Reuyl. Appellant's recognition of the problem of a hidden life-threatening hazard posed by an automatic generator starting system—rather than an engine that is already running—must be given weight. *See Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) (obviousness must consider invention as a whole, i.e., the particular problem solved).

Because Reuyl and James do not suggest being combined as in the rejection, no *prima facie* case of obviousness exists with respect to these claims, requiring reversal of the rejection.

For claim 5, Reuyl and/or James do not suggest automatically starting a fuel-powered AC generator when a load circuit—that includes an at least partially AC-powered electrical appliance of a vehicle—needs AC power from the AC generator. James omits automatically starting an AC generator. Reuyl is used in a conventional (non-vehicular) home. (*See, e.g.*, Reuyl at col. 4, line 61, discussing “when the automobile is parked at the residence,” etc.). Because Reuyl and/or James omit this, no *prima facie* case of obviousness exists for claim 5, requiring reversal.

For claims 7 and 21, Reuyl and/or James omit a transmission position detector circuit that is used to inhibit the automatically starting the fuel-powered AC generator. Instead, the transmission position detector circuit of James detects whether the already-running engine is present in a potentially moving vehicle, in which case disabling of the already-running engine is inhibited. (*See* James at col. 11, lines 42-50 and col. 5, lines 24-31.) Because Reuyl and/or James omit this, no *prima facie* case of obviousness exists for claim 7, requiring reversal.

2. The § 103 Rejection of claims 2, 4 using Reuyl in view of James and Ulinski

This rejection of these claims requires reversal for the reasons discussed above under (1).

For claim 4, Reuyl, James, and/or Ulinski omit inhibiting automatic starting of a diesel generator, as opposed to a spark-ignited engine. (See Application at page 4, lines 10-12.) These references fail to recognize an exhaust hazard of a diesel engine, requiring reversal.

3. The § 103 Rejection of claims 9, 13, 23, 26, 28 and 29 using Reuyl, James and Ito

This rejection of these claims requires reversal for the reasons discussed above under (1).

For claims 9, 23, and 26, Reuyl, James, and/or Ito omit using a wheel rotation sensor to inhibit auto-starting the fuel-powered AC generator. Ito's wheel rotation sensor merely provides turning control. (See Ito at Abstract). Reversal is required.

For claims 13, 28, and 29, Reuyl, James, and/or Ito omit using an ignition key position sensor to inhibit auto-starting the generator. The rejection fails to explain how Ito is being applied to overcome the shortcomings of Reuyl and James. Reversal is required.

4. The § 103 Rejection of claims 8, 11, 12, 14-15, 22, 25, 27, 30-34 using Reuyl, James, Ito, and Riedel

This rejection of these claims requires reversal for the reasons discussed above under (1).

For claim 8, Reuyl, James, Ito, and/or Riedel omit a data link to provide data used to inhibit auto-starting the generator. The rejection admits that Riedel is for controlling engine efficiency. Reversal is required.

For claim 11, Reuyl, James, Ito, and/or Riedel omit using an engine operation sensor to inhibit auto-starting the generator. The rejection admits that Riedel is for controlling engine efficiency. Reversal is required.

For claim 12, Reuyl, James, Ito, and/or Riedel omit using an rpm sensor to inhibit the auto-starting the generator. The rejection admits that Riedel is for controlling engine efficiency. Reversal is required.

For claim 22, Reuyl, James, Ito, and/or Riedel omit using a data link to detect vehicle transmission position to inhibit auto-starting the generator. Instead, the rejection admits that Riedel is for controlling engine efficiency. Reversal is required.

For claim 25, Reuyl, James, Ito, and/or Riedel omit using a data link to detect wheel rotation to inhibit auto-starting the generator. Instead, the rejection admits that Riedel is for controlling engine efficiency. Reversal is required.

For claim 27, Reuyl, James, Ito, and/or Riedel omit detecting a change in vehicular engine operation from engine running to engine off to inhibit the auto-starting the generator. Instead, the rejection admits that Riedel is for controlling engine efficiency. Reversal is required.

For claims 30-31, Reuyl, James, Ito, and/or Riedel omit detecting a change in vehicular ignition state to auto-starting the generator. Instead, the rejection admits that Riedel is for controlling engine efficiency. Reversal is required.

5. The § 103 Rejection of claim 3 using Reuyl, James, and Graber

This rejection of these claims requires reversal for the reasons discussed above under (1).

6. The § 103 Rejection of claims 10 and 24 using Reuyl, James , Ito, and Duke

This rejection of these claims requires reversal for the reasons discussed above under (1).

For claims 10 and 24, Reuyl, James, Ito, and/or Duke omit using a reluctance sensor to inhibit auto-starting the generator. Instead, the rejection admits that Duke is for conserving fuel. Reversal is required.

7. The § 103 Rejection of claims 6, 16, 17-19 and 35 using Reuyl, James , and Kawaguchi

This rejection of these claims requires reversal for the reasons discussed above under (1), since Kawaguchi fails to cure the above-noted deficiencies in the rejection using Reuyl and James by merely coupling an engine-generator to a recreational vehicle.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at (612) 373-6951 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DAN G. PRIEM

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6951

Date January 31, 2006 By S. Arora
Suneel Arora
Reg. No. 42,267

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 31st day of January, 2006.

PATRICIA A. HULTMAN

Name

Signature

